

REMARKS

Claims 5-23 are pending in the application. Claims 5 and 14 are the independent claims.

Information Disclosure Statements

On March 4, 2003, Applicant filed an Information Disclosure Statement comprising all references cited by or to the Examiner in an earlier application relied on for an earlier effective filing date under 35 U.S.C. § 120 (see CROSS-REFERENCES TO RELATED APPLICATIONS section of the specification). Included in this March 4, 2003 filing were the following documents from the earlier application's prosecution history:

- a first Information Disclosure Statement (one page) and associated form PTO-1449 (two pages) dated 7/6/98
- a second Information Disclosure Statement (three pages) and associated form PTO-1449 (one page) dated 12/4/98
- a third Information Disclosure Statement (one page) and associated form PTO-1449 (one page) dated 12/4/98
- Notice of References Cited form PTO-892 (one page)

In the present Office action, the Examiner only provided an initialed list of references from the two page form PTO-1449 (dated 7/6/98), excluding the bottom most reference on the first page which was cut off. Applicant respectfully requests that the Examiner initial this bottom most reference and the remaining disclosed references in order to provide a record of the Examiner's consideration of those references.

The Double Patenting Rejection Is Overcome

The Examiner rejected claims 1-4 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 18 of U.S. Patent No. 6,236,409 B1 ("the '409 patent") in view of Pelletier (U.S. Patent No. 5,579,519). Applicant respectfully traverses the combination of Pelletier with the '409 patent under this rejection, in addition to the Examiner's interpretation of the term "global switch" in the present claim language.

However, for reasons unrelated to this rejection, Applicant has canceled claims 1-4. Thus, since claims 1-4 are no longer pending in the application, Applicant respectfully requests that the double patenting rejection be withdrawn.

The Enablement Requirement Is Overcome

The Examiner rejected claims 1-4 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Applicant respectfully traverses this rejection, since the use of a "document-use" global switch is clearly enabled by the specification.

However, for reasons unrelated to this rejection, Applicant has canceled claims 1-4. Thus, since claims 1-4 are no longer pending in the application, Applicant respectfully requests that the § 112 rejection be withdrawn.

The Independent Claims Patentably Define the Invention Over Johnson

The Examiner rejected all of the pending independent claims (claims 5 and 14) under 35 U.S.C. § 103(a) as being unpatentable over Johnson (U.S. Patent No. 5,625,776).

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art teach or suggest each element of the claim, the prior art must also suggest combining the elements in the manner contemplated by the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F. 2d 931, 934 (Fed. Cir. 1990); In re Bond, 910 F. 2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a prima facie case of obviousness. M.P.E.P. § 2142. To establish a prima facie case of obviousness, the Examiner must show that three basic criteria are met. M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references' teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference or references, when so modified or combined, must teach or suggest all of the claim limitations. Id. Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not in applicant's disclosure. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991). Finally, in discharging the initial burden of establishing a prima facie case, the Examiner must make particular findings as to establish the motivational element. In re

Kotzab, 217 F.3d 1365 (Fed. Cir. 2000). That is, the PTO cannot rely on mere conclusory statements but instead must explain its reasoning why one of ordinary skill would be motivated to select the references and combine them to reach the claimed invention, and must provide evidence to support such a motivation. In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

Applicants respectfully submit that none of these criteria for obviousness are met for at least the following reasons.

Johnson Does Not Teach or Suggest Generating an Overlay Representing a Request for Proposal

All of the pending independent claims (claims 5 and 14) recite, in part, generating an overlay representing a request for proposal. None of the references cited by the Examiner, taken alone or in combination, teach or suggest such a limitation.

In particular, in rejecting independent claim 1, the Examiner cites Johnson for disclosing every claim element except for “request for proposal”. The Examiner concedes that “Johnson does not disclose expressly the ‘request for proposal’ . . .” (Office action, page 6, para. 1), but fails to cite any reference that does. The Examiner only states that “it would have been obvious . . . to customized, high-quality proposals which has many potential applications, and will have a great appeal to each individual customer and will be an asset in selling the product.” Office action, page 6, para.1. While Applicants request clarification of this statement due to its ambiguity both from a grammatical and logical standpoint, the statement clearly offers no teaching or suggestion of generating an overlay representing a request for proposal as claimed.

If the Examiner is impliedly taking official notice of a teaching or suggestion of generating an overlay representing a request for proposal, then Applicants respectfully traverse this implied taking and officially request that the Examiner provide documentary evidence of this teaching or suggestion in the next action if this rejection is to be maintained. M.P.E.P. § 2144.03.

Additionally, in rejecting independent claim 14, the Examiner does not even cite any teaching or suggestion for this missing claim element. See Office action, pages 8-9, para. 9.

Johnson is merely directed to the creation of a product brochure by linking together assorted pictures and text associated with the product. There is no teaching or suggestion in Johnson of anything related to a request for proposal as claimed.

Accordingly, Applicants respectfully submit that the Examiner does not establish a prima facie case of obviousness because the prior art, however modified or combined, fails to teach or suggest all the claim limitations. For at least these reasons, all of the pending independent claims (claims 5 and 14), along with their respective dependent claims 6-13 and 15-23, are not rendered obvious under 35 U.S.C. § 103(a).

Johnson Does Not Teach or Suggest Associating an Appropriate Grammatical Mood with a Text Segment Based on a Received Indicated Document Function

Independent claim 14 recites, in part, associating an appropriate grammatical mood with a text segment based on a received indicated document function. None of the references cited by the Examiner, taken alone or in combination, teach or suggest such a limitation.

In particular, in rejecting independent claim 14, the Examiner appears to cite Johnson for disclosing every claim element, but does not identify where in Johnson there is any teaching or suggestion for these missing claim elements. See Office action, pages 8-9, para. 9.

If the Examiner is impliedly taking official notice of a teaching or suggestion of associating an appropriate grammatical mood with a text segment based on a received indicated document function, then Applicants respectfully traverse this implied taking and officially request that the Examiner provide documentary evidence of this teaching or suggestion in the next action if this rejection is to be maintained. M.P.E.P. § 2144.03.

Again, Johnson is merely directed to the creation of a product brochure by linking together assorted pictures and text associated with the product. There is no teaching or suggestion in Johnson of anything related to receiving an indication of document function, nor associating an appropriate grammatical mood with a text segment based on the indicated document function as claimed.

Accordingly, Applicants respectfully submit that the Examiner does not establish a prima facie case of obviousness because the prior art, however modified or combined, fails to teach or suggest all the claim limitations. For at least these reasons, independent claim 14, along with its respective dependent claims 15-23, are not rendered obvious under 35 U.S.C. § 103(a).

CONCLUSION

It is respectfully submitted that, in view of the foregoing remarks, the application is in clear condition for allowance. Issuance of a Notice of Allowance is earnestly solicited.

The Office is authorized to charge the two-month small entity extension of time fee of \$210.00 to Deposit Account No. 11-0600. Although not believed necessary, the Office is hereby authorized to charge any additional fees required under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayments to Deposit Account No. 11-0600. A copy of this page is provided for this purpose.

The Examiner is invited to contact the undersigned at 202-220-4200 to discuss any matter regarding this application.

Respectfully submitted,

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